

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAX B. COWDEN, KEVIN V. DAHLSTROM,
SCOTT G. EAGLE, CHARELS GILBERT, PHILIP D. HOLLRAH,
ANTHONY G. MARTIN, JEFFREY A. MCFADDEN,
MARK E. PENNELL, and MARC E. SILVERBERG

Appeal 2007-2457
Application 09/993,906
Technology Center 2100

Decided: December 11, 2007

Before: JAMES THOMAS, ALLEN R. MACDONALD,
and THU A. DANG, *Administrative Patent Judges.*

DANG, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal the Examiner's final rejection of claims 1 and 3-9 under 35 U.S.C. § 134(2002). We have jurisdiction under 35 U.S.C. § 6(b)(2002).

A. INVENTION

According to Appellants, the invention is a method wherein a partially disabled computer program is installed in a computer and a user is informed of the usefulness of the computer program when the user tries to uninstall the computer program (Spec. 29-31; App. Br. 2). In one embodiment, a product list is included which provides a description of computer programs to aid users in deciding whether they should install a computer program being offered to them (Spec. 28).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. A method to be performed in a computer, the method comprising:
installing a computer program in the computer, the computer program being partially disabled as installed;
offering the computer program to the user after installation of the computer program in the computer;
providing the computer program to the user after the user accepts the offer; and
informing the user of usefulness of the computer program when the user tries to uninstall the computer program after accepting the offer.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Humes US 5,996,011 Nov. 30, 1999
Cinecom Corporation, Cine Video Direct, Jan. 15, 1997.
InfoWorld publishing Co., Real Demos Online software, Feb. 5, 1997.
Quarterdeck Corporation, CleanSweep 95 Reviewers Guide, Oct. 30, 2001.

Claims 1, 4, and 7 stand rejected under 35 U.S.C. § 103(a) over the teachings of InfoWorld and Quarterdeck;

Claims 3, 6, 8, and 9 stand rejected under 35 U.S.C. § 103(a) over the teachings of InfoWorld and Quarterdeck, and Humes; and

Claim 5 stands rejected under 35 U.S.C. § 103(a) over the teachings of InfoWorld and Quarterdeck, and Cinecom.

We affirm.

II. ISSUES

The issues are whether Appellants have shown that the Examiner erred in finding that

A. Claims 1, 4, and 7 are unpatentable under 35 U.S.C. § 103(a) over the teachings of InfoWorld and Quarterdeck;

B. Claims 3, 6, 8, and 9 are unpatentable under 35 U.S.C. § 103(a) over the teachings of InfoWorld, Quarterdeck and Humes; and

C. Claim 5 is unpatentable under 35 U.S.C. § 103(a) over the teachings of InfoWorld, Quarterdeck and Cinecom.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Appellants' Invention

1. In one embodiment of Appellants' invention, product list 322 includes a description of computer programs to aid users in deciding whether they should install a computer program being offered to them (Spec. 28, ll. 13-15).
2. In Appellants' disclosure, the term "window" is used to refer to any mechanism for presenting the information to a user (Spec. 5, ll. 19-20).
3. The filing date of the Application to Appellants' invention is November 27, 2001.

InfoWorld

4. InfoWorld discloses a technology and service which allows software publishers to easily create pay-upon download and try-before-you-buy software. The users are offered the opportunity to use the technology to create try-before-you-buy and pay-upon-download software (p. 1, para. 1). After a demo application's trial period ends, SalesAgent

allows users to instantly turn their “demo” into a full, purchased product (p. 1, para. 3).

Quarterdeck

5. Quarterdeck discloses selecting and clicking on a file/program name to view the description of the file/program. In particular, Quarterdeck discloses a Cleanup Program, CleanSweep 95, with uninstaller functions, wherein the user interface to CleanSweep 95 leads the user through the uninstallation of programs and allows the user to view of a list of the actions that it is about to perform (p. 8, paras. 9-11). A “View” button on the user interface allows the user to check the contents of files that are candidates for deletion (p. 9, para. 1). The user interface provides information to suggest whether a file is a good candidate for deletion and provides an explanation describing what the component does, identifies its relationship to other programs, and provides a recommendation in plain English (p. 8, para. 11).
6. Quarterdeck discusses the features of CleanSweep 95 as it existed on October 30, 2001.

Humes

7. Humes discloses filtering data as received, so called “on the fly,” so that a newly created web page may be filtered as accurately as one that has been predetermined to contain objectionable material (col. 2, ll. 31-38). While the filter will decide whether or not to block access to the entire web page based on the URL, depending on its processing

- of the body of the web page, the filter may deny access completely to the web page, deny access to certain portions of the web page (i.e., filter out some objectionable words), or allow complete access to the web page (col. 3, ll. 3-9). If the requested URL is found in the forbidden list, a message is transmitted to the user's computer indicating that access to the web page is forbidden (col. 3, ll. 14-22).
8. Humes illustrates a scoring technique in filtering the web pages. Decision block 522 determines whether the "Score" for a web page exceeds the predetermined "Targetscore" threshold, and, if so, the web page is filtered and/or blocked for viewing by the user (col. 8, ll. 43-58 and fig. 5).

Cinecom

9. Cinecom discloses the process of downloading trial and demo software to purchase full, registered versions by downloading complete versions of the application over the Internet from a remote computer (p. 1, paras. 1-4).

IV. PRINCIPLES OF LAW

35 U.S.C. § 103(a)

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls."). The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 17-18. "If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under § 103." *KSR*, 127 S. Ct. at 1734.

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248 [(1850)]." *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional

approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently concluded that it would have been obvious to combine (1) a device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) a processor-driven device capable of playing the sound associated with a first letter of a word in a book. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007). In reaching that conclusion, the Federal Circuit recognized that "[a]n obviousness determine is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Id.* at 1161 (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)).

Although the combination of prior art references lacked a "reader" to automatically identify the book inserted in the device, the Federal Circuit found no error in the District Court's determination that readers were well known in the art at the time of the invention. *Id.* at 1162. In addition, the Court found that the reasons for adding a reader to the combination of prior art references "are the same as those for using readers in other children's toys-namely, providing an added benefit and simplified use of the toy for the child in order to increase its marketability." *Id.* at 1162. The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

However, nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Claim Construction

"Our analysis begins with construing the claim limitations at issue." *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007).

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)).

"Claims must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc).

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

V. ANALYSIS

35 U.S.C. § 103(a)

A. Claims 1, 4, and 7

As to claims 1 and 7, the Appellants argue “The most Quarterdeck can do is give a description of the program and how safe it is to remove the program from the computer” and “[t]he ‘description’ provided by Quarterdeck is thus nothing more than telling the user what the program is for safety reasons” (App. Br. 5). We agree.

However, we also find that the Quarterdeck description is useful information to the user regarding the computer program, as it assists the user in determining whether or not to keep the computer program when the user tries to uninstall the computer program. Thus, the description of the computer program provided by Quarterdeck meets the definition of “usefulness” as set forth in Appellants’ invention. That is, Appellants’ own disclosure sets forth that a description of a computer program informs the user of the usefulness of the computer program to aid users in deciding whether they should install a computer program being offered (FF 1). Accordingly, we find that the combination of InfoWorld and Quarterdeck teaches or suggests all elements of claims 1 and 7.

Though Appellants further argue that “Quarterdeck does not teach or suggest **reminding the user of the usefulness** of the computer program to be uninstalled” (App. Br. 5), no where in any of the claims does such “reminding” step appear.

Additionally, we note that the feature “usefulness” in “informing the user of usefulness of the computer program” is a nonfunctional descriptive material that is not functionally related to the step of “informing the user.” Such “usefulness” feature does not change the functionality of or provide an additional step to the “informing the user” step of the claimed method, but rather, is a determination made by the human user. When the descriptive material is not functionally related to the claimed step, the descriptive material will not distinguish the invention from the prior art in terms of patentability. Accordingly, we find that Quarterdeck discloses at least the recited step of “informing the user” and the feature “usefulness” does not distinguish the claims from Quarterdeck in terms of patentability.

Appellants do not provide a separate argument for claim 4, and thus, claim 4 stands or falls with claim 1.

For at least the above reasons, we conclude that Appellants have not shown that the Examiner erred in rejecting claims 1, 4, and 7 under 35 U.S.C. § 103(a).

B. Claims 3, 6, 8, and 9

Claim 3 and 9:

Appellants argue that “Humes does not teach or suggest keeping track of the number and types of windows in a computer” (App. Br. 5), and “Humes does not disclose detecting types of windows” (App. Br. 6). However, no where in any of the claims does such “tracking” or “detecting” step appear.

As noted above, the feature “usefulness” in “informing the user of usefulness of the computer program” is a nonfunctional descriptive material that is not functionally related to the claimed step of “informing the user,” and does not distinguish the invention from the prior art in terms of patentability.

Similarly, “informing a user of the usefulness of a computer program includes informing the user a number of a type of window detected by the computer program” also is a nonfunctional descriptive material that does not add any further function to the claimed step of “informing the user.” That is, “a number of a type of window” is merely descriptive of the information provided to the user which does not provide any additional functional step to the claimed “informing the user” step.

Accordingly, we find that the combination of InfoWorld, Quarterdeck and Humes discloses at least the recited step of “informing the user” and the feature “informing the user [of] a number of a type of window” does not distinguish the claims from the prior art in terms of patentability.

Claims 6 and 8:

Appellants argue that Humes discusses “filtering of web pages” and that “Humes discloses content (e.g., web page) filtering” (App. Br. 7). We agree. However, we also find that the blocking of a web page by Humes includes the blocking of a window as defined by Appellants.

As set forth in the Appellants’ disclosure, “the term ‘window’ is used to refer to any mechanism for presenting information to a user” (FF 1). Thus, a “web page”, i.e., the page the user sees on the internet is such

mechanism for presenting information to a user. Humes discloses blocking of such mechanism for presenting information.

Appellants' argument that "Humes cannot block proliferation of pop-up windows" is not persuasive in that there is no such blocking of proliferation of pop-up windows recited in the claims.

Motivation to Combine:

Appellants further argue the Examiner erred in that "[t]here is no suggestion or motivation to combine Humes with InfoWorld and Quarterdeck" because "there is no teaching in InfoWorld, Quarterdeck, or Humes to inform the user of the number and type of windows detected by a computer program, especially at a time when the user uninstalls that computer program" (App. Br. 7). We disagree.

The claims do not recite any such step of informing the user of "the number and type of windows" as argued by Appellants. Further, as discussed above, we find that the feature "informing a user of the usefulness of a computer program includes informing the user a number of a type of window detected by the computer program" does not distinguish the claims from the prior art in terms of patentability.

Furthermore, since informing the user a number of a type of window detected is merely a type of information provided to a user upon uninstallation, it would require no more than "ordinary skill and common sense," *KSR*, 127 S. Ct. at 1742, to provide the user such information upon installation. One of ordinary skill in the art would have pursued the known potential solutions to the problem for the benefit of tracking the total score

in filtering windows. Appellants have presented no evidence that selecting a computer program for informing the user a number of a type of window detected is as a type of computer program to be performed on a computer "was uniquely challenging or difficult for one of ordinary skill in the art," *Leapfrog*, 485 F.3d at 1162, nor has Appellants presented evidence that this "represented an unobvious step over the prior art" *id.*

Thus, by determining whether the "Score" for a web page exceeds the predetermined "Targetscore" threshold, Humes pursued the known potential solutions to the problem for the benefit of tracking the total score for filtering information provided to the user.

We find that the combination of InfoWorld, Quarterdeck, and Humes teaches or suggests all elements of claims 1, 3, 8, and 9. Accordingly, we conclude Appellants have not shown that the Examiner erred in rejecting claims 3, 6, 8, and 9 under 35 U.S.C. § 103(a).

C. Claim 5

Appellants argue that "Cinecom does not teach or suggest downloading of components of a computer program in between offer and acceptance of the computer program." We disagree.

As Appellants acknowledge, Cinecom "discloses downloading **trial or full versions** of a computer program" (App. Br. 8). By their nature full versions must include components. Thus, we conclude that the Examiner did not err in asserting that full versions of a computer program include components of the computer program.

We find that the combination of InfoWorld, Quarterdeck, and Cinecom teaches or suggests all elements of claim 5. We conclude Appellants have not shown that the Examiner erred in rejecting claim 5 under 35 U.S.C. § 103(a).

D. Quarterdeck is Prior Art

Appellants' argue that "With a filing of November 27, 2001, it is believed that Quarterdeck is not prior art to the present application."

As set forth by the Examiner, Quarterdeck discusses the features of CleanSweep 95 as it existed on October 30, 2001, prior to the filing of November 27, 2001 of the present application. No evidence has been presented by the Appellants that is contrary to the Examiner's finding.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in applying Quarterdeck as prior art to the present application.

CONCLUSIONS OF LAW

(1) Appellants have not shown that the Examiner erred in finding claims 1, 4, and 7 are unpatentable over the teachings of InfoWorld and Quarterdeck.

(2) Appellants have not shown that the Examiner erred in finding claims 3, 6, 8, and 9 are unpatentable over the teachings of InfoWorld, Quarterdeck and Humes.

Appeal 2007-2457
Application 09/993,906

(3) Appellants have not shown that the Examiner erred in finding claim 5 is unpatentable over the teachings of InfoWorld, Quaterdeck and Cinecom.

(4) Claims 1 and 3-9 are not patentable.

DECISION

The Examiner's rejection of claims 1 and 3-9 under 35 U.S.C. §103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

CLARIA CORPORATION
c/o HAYNES BEFFEL & WOLFELD LLP
P.O. BOX 366
751 KELLY STREET
HALF MOON BAY CA 94019